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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/544,222

08/02/2005

Michael Smolong

48753

9493

1609

7590

02/05/2010

ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.

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SUITE 600

WASHINGTON,, DC 20036

EXAMINER

IRVIN, THOMAS W

ART UNIT

PAPER NUMBER

3657

MAIL DATE

DELIVERY MODE

02/05/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/544,222	<b>Applicant(s)</b> SMOLONG ET AL.	
	<b>Examiner</b> THOMAS IRVIN	<b>Art Unit</b> 3657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 12 and 14-21 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

In view of the Appeal Brief filed on 23 October 2009, PROSECUTION IS  
HEREBY REOPENED. A New grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the  
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply  
under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed  
by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and  
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth  
in 37 CFR 41.20 have been increased since they were previously paid, then appellant  
must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by  
signing below:

/Robert A. Siconolfi/

Supervisory Patent Examiner, Art Unit 3657.

### ***Claim Objections***

Claim 11 is objected to because of the following informalities: "outlet" in lines 5  
and 6 should be changed to read -- inlet --. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomita et al. (4,693,133) in view of Ward (5,279,391).

In Re claim 11, Tomita et al. disclose a lubricating device, comprising: first (32) and second (18) gear stages mounted next to one another and dynamically connected to one another (see fig. 4); a lubricant circuit (see fig. 5), having a lubricant supply (48) for providing lubricant to said first gear stage, having a lubricant inlet (26) for removing lubricant from said second gear stage, and circulating lubricant drawn from said lubricant inlet to said lubricant supply; and an immersion bath (46, 50) receiving individually and at least partially each of said gear stages for said gear stages to pass through said immersion bath for splash lubrication of said gear stages, said immersion bath having a lubricant reserve and a subdivision (44) separating said immersion bath into first and second bath areas for said first and second gear stages, respectively, said subdivision having a configuration and said lubricant reserve having an amount such that lubricant overflows said subdivision to be conveyed from said first bath area to said second bath area, said first bath area having said lubricant supply, said second bath area having said lubricant outlet. Tomita et al. fail to teach a filter.

Ward teach including a filter (48) in a transmission lubrication circuit (44,50-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the lubricating device of Tomita et al. to include a filter, as taught by Ward, to clean and strain the oil of any contaminants to protect the gears, chain, and pump.

In Re claim 12, the examiner points out that the claims are directed to a lubricating device, and that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The transmission of Tomita et al. is understood to be capable of being used as a transmission for a wind power station.

In Re claim 14, said lubricant inlet comprises a suction device, pump (24); said lubricant supply comprises an injection device, passageway (48); and said first and second gear stages are mounted in a gear housing (12) with said injection device and said suction device being located diagonally opposite one another in an upper area and a lower area, respectively, of said housing (see fig. 4).

In Re claim 15, the lubrication circuit of Tomita et al. is on a motor of a vehicle, and is thus understood to meet the limitations of “motor pump”.

In Re claim 16, see fig. 1 of Ward.

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Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomita et al. (4,693,133) in view of Ward (5,279,391) as applied to claim 11 above, and further in view of Sann et al. (WO 02/062447).

Tomita et al., as modified, teach the claimed invention except failing to teach the specifics of the filter unit.

Sann et al. teach, with reference to Fig. 1, a filter unit (10) having a first fine filter (12), which is safeguarded with a bypass (22), and a coarse filter (32) connected in series with the first filter. The filter fineness of the coarse filter meets the limitations of being approximately 5 to 10 times greater than the filter fineness of the fine filter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transmission of Tomita et al., as modified, to include a filter unit with two filters and a bypass, as taught by Sann et al., to fully strain the lubrication oil of any contaminants.

### ***Allowable Subject Matter***

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments, see Appeal Brief, filed 23 October 2009, with respect to the rejection(s) of claim(s) 11-21 have been fully considered and are persuasive.

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Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tomita et al. (4,693,133).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS IRVIN whose telephone number is (571)270-3095. The examiner can normally be reached on M-F 10-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas Irvin/  
Examiner, Art Unit 3657

/Bradley T King/  
Primary Examiner, Art Unit 3657